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S. Zimmerman
4-16-03
PATENT APPLICATION AF/3750

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A8038

BRYAN, VINCENT, et al.

Appln. No.: 08/944,234

Group Art Unit: 3727

Confirmation No.: 1173

Examiner: Lien M. Ngo

Filed: October 6, 1997

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For: DRILL HEAD FOR USE IN PLACING A VERTEBRAL BODY DISC DEVICE

PETITION UNDER 37 C.F.R. § 1.181

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants petition from the Examiner's new matter objection, in the Final Office Action dated February 11, 2003, to the addition of figures and written-description to the substitute specification. The subject matter added to the substitute specification is based on the disclosure of U.S. Patent 5,674,296 (Bryan *et al.*) ('296 patent), which was expressly incorporated by reference in the present application as originally filed, and the new matter objection is manifestly improper.

I. THE PETITION SEEKS RELIEF UNDER 37 C.F.R. §1.181(a) AND (c)

A. Relief under 37 C.F.R. §1.181(c) is Appropriate

The present petition seeks relief under 37 C.F.R. §1.181(c), to invoke the supervisory authority of the Commissioner, with respect to whether the Examiner has properly objected to disclosure incorporated by reference from a United States patent, as new matter. This question is properly reviewed by petition, as recognized in *In re Goodwin*, 43 U.S.P.Q.2d 1856 (1997) (unpublished decision) (copy attached).

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A number of circumstances compel the exercise of supervisory authority with respect to the Examiner's objections to the figures and the substitute specification. First, it is clear that disclosure from a United States patent which is properly incorporated by reference cannot constitute new matter, as stated in MPEP §608.01(p) and confirmed by *In re Goodwin*. The Examiner's new matter objection with respect to disclosure that is properly incorporated by reference is thus manifestly incorrect. Furthermore, the Examiner has failed to state any reason why the subject matter objected to is not properly incorporated by reference, and instead evidently relies on a legally incorrect theory that Applicants cannot amend the specification and drawings to include matter expressly incorporated by reference from the '296 patent. The Examiner has not responded to the Applicants' detailed explanation of the reasons why Figs. 4-7 and paragraphs 10, 40-46, and 47-53 of the substitute specification do not constitute new matter.

Applicants also emphasize that they have requested that an interference be declared between the present application and U.S. Patent 6,083,228 (Michelson), under 37 C.F.R. §1.607. Under 37 C.F.R. §1.607(b), "[w]hen an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office." Applicants are thus entitled to expedited examination of their claims, based on the disclosure of the complete specification including subject matter originally incorporated by reference and added to the substitute specification in response to the first Office Action.

Under these circumstances, Applicants submit that the petition should be granted, both to ensure the examination of the present application with special dispatch, and to avoid the needless waste of the resources of the Office, the Board, and the Applicants that would result from an appeal.

B. Relief under 37 C.F.R. §1.181(a) is Appropriate

The present petition also seeks relief under 37 C.F.R. §1.181(a), because it involves requirements of the Examiner in *ex parte* prosecution which may not be subject to review by the Board of Patent Appeals and Interferences. Applicants point out, for example, that the Examiner has objected to the drawings as not showing every feature specified in the claims, referring specifically to the predetermined shape of the endoprosthesis (Claim 18), the concaval-convex shape of an endoprosthesis (Claim 24), and the surface contour in one of the adjacent vertebral bodies (Claims 24). Claims 18 and 24 are not rejected under 35 U.S.C. §112, first paragraph. These objections to the drawings, which include both objections to the original drawings 1-3 and the new matter objections with respect to Figs. 4-7 incorporated from the '296 patent, are thus properly reviewed by petition under 37 C.F.R. §1.181(a).

II. POINTS TO BE REVIEWED

Applicants petition from the Examiner's new matter objections to Figs. 5-7 and paragraphs 10, 40-46, and 47-53 and the Examiner's requirement that Applicants cancel Figs. 5-7 and paragraphs 10, 40-46, and 47-53 from the substitute specification. To the extent that the Examiner objects to the addition of Fig. 4 to the application, applicants also petition from this objection. Applicants further petition from the Examiner's objections to original Figs. 1-3, which the Examiner maintains do not show every feature specified in the claims. The objections to be reviewed are as follows:

A. New Matter Objections

The Examiner objects to the addition of Figs. 5-7, and to paragraphs 10 and 40-46 of the substitute specification, which relate to a spinal endoprosthesis, as new matter. (Office Action, ¶¶1-2). The Examiner also appears to object to Fig. 4 (Office Action,

¶10, page 7, second paragraph), although he does not expressly state that Fig. 4 is new matter.

The Examiner also objects to the amendment adding paragraphs 47-53 to the substitute specification, and to the abstract, which relate to the method of milling a vertebral body, as new matter (Office Action, ¶2).

The Examiner states that applicants are required to cancel the "new matter" in the reply to the Office Action (Office Action, ¶2).

B. Objections to the Original Drawings

The Examiner additionally objects to original Figures 1 to 3 as not showing every feature specified in the claims, referring specifically to the predetermined shape of the endoprosthesis (Claim 18), the concaval-convex shape of an endoprosthesis (Claim 24) and the surface contour in one of the adjacent vertebral bodies (Claim 24, which has not been rejected under 35 U.S.C. § 112, ¶1. The Examiner has also objected to original Figs. 1 to 3 in rejecting Claims 25-125, including Claims 41, 47, 67, 82, 97, 114, 119, 120, 121); the width of the insert (Claims 41, 49); the milling surface "parallel to a receiving surface (Claims 49, 85, 102); and two predetermined surface contours (Claims 77, 93, 110). The Examiner also objects to the original drawings as not disclosing the steps of method Claims 62-66.

It is respectfully submitted that these objections should be reviewed by petition under 37 C.F.R. §1.181(c), insofar as the objections to the original drawings also relate to the rejection of claims 25-125 under 35 U.S.C. §112, first paragraph.

III. STATEMENT OF ACTION REQUESTED

Applicants request that the Examiner be required to withdraw the new matter objections with respect to Figs. 5-7 and paragraphs 10, 40-46, and 47-53 and to withdraw

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the requirement that Applicants cancel Figs. 5-7 and paragraphs 10, 40-46, and 47-53 from the substitute specification.

Applicants request that, to the extent that the Examiner objects to Fig. 4, the Examiner be required to withdraw this objection.

Applicants request that the Examiner be required to withdraw the objections to original Figs. 1-3.

In view of the requirement of 37 C.F.R. §1.607(b), Applicants respectfully request that the finality of the Office Action dated February 11, 2003, should be withdrawn, and that the objections posed by the Examiner should be reconsidered, on the basis of the substitute specification and Figs. 1-7, which do not contain new matter, and fully describe the invention that is claimed.

Applicants are entitled to have their claims examined with special dispatch on the basis of the disclosure of the substitute specification and figures.

IV. STATEMENT OF FACTS

Contrary to the Examiner's position, the incorporation by reference of disclosure and figures from the '296 patent does not constitute new matter. Paragraphs 10, 40-46, and 47-53 of the substitute specification, and Figs. 4-7 of the substitute specification, are each based on the disclosure of United States Patent 5,674,296 (copy attached). The specification as originally filed expressly incorporates by reference the '296 patent (page 3, lines 7-8). Accordingly, no question of new matter arises from the amendment of the specification to include additional disclosure from the '296 patent.

More particularly, as Applicants have explained in detail in the response to the first Office Action, the disclosure added to the substitute specification is supported by the corresponding disclosure of the '296 patent, with reference to the paragraph numbers of

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the substitute specification and the columns and line numbers of the '296 patent, as follows:

SUBSTITUTE SPECIFICATION

Paragraph 10

Paragraph 40

Paragraph 41

Paragraph 42

Paragraph 43

Paragraph 44

Paragraph 45

Paragraph 46

Paragraph 48

Paragraph 49

Paragraph 50

Paragraph 51

Paragraph 52

Paragraph 53

'296 PATENT

Abstract

Figs. 1-4; col. 3, lines 8-18

col. 3, line 58-col. 4, line 1

col. 4, lines 6-17

col. 4, lines 17-30

col. 4, lines 31-52

col. 4, lines 6-17

col. 2, lines 31-33

col. 2, lines 31-33

col. 6, lines 16-38

col. 6, lines 40-46

col. 6, lines 47-56

col. 4, lines 6-18

col. 6, line 65-col. 7, line 2

not true

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not true

SUBSTITUTE SPECIFICATION

Fig. 4

Fig. 5

Fig. 6

Fig. 7

'296 PATENT

Fig. 1

Fig. 2

Fig. 3

Fig. 4

A comparison of Figs 4-7 of the substitute specification with Figs 1-4 of the '296 patent demonstrates that each of these figures is a copy of the '296 figures incorporated by reference, with new reference numerals to correspond to the disclosure of the substitute specification.

SUBSTITUTE SPECIFICATION

Abstract

'296 PATENT

col. 6, line 16 to col. 7, line 2

DISCLOSURE PRESENT IN ORIGINAL SPECIFICATION

Paragraph 47 of the substitute specification describes features of the invention shown in Figs. 1-3 of the original specification and by Figs 4-6, and is supported by page 5, lines 7-14 of the original specification as filed and by col. 3, line 58 to col. 4, line 1, and col. 6, lines 57-62 of the '296 patent.

Paragraph 52 of the substitute specification is supported by col. 6, lines 56-62 of the '296 patent, and by the original specification, page 5, lines 7-18. Figure 2 discloses a rotary form cutter 29 that has two distinct milling surfaces, an inner convex milling surface 42, surrounded by an outer concave milling surface which terminates at peripheral edge 44 (Specification, ¶¶25-26), and thus shows a form cutter having at least one milling surface 42, 44 as stated in Paragraph 52.

The substitute specification thus does not contain new matter, and the Examiner's objections are without basis in fact or law.

V. THE OBJECTIONS ARE MANIFESTLY INCORRECT AS A MATTER OF LAW

The Examiner has failed to set forth any reason why the amendments introducing figures and disclosure from the '296 patent are new matter, and has failed to explain why the substitute specification and figures do not overcome the objections to original Figs. 1-3.

The Examiner's new matter objections appear to be based on an incorrect theory that the disclosure of the '296 patent cannot be added to the specification. For example, in the Office Action (§10) the Examiner argues that "the *original* specification does not describe to the *new figures*, and the *original drawings* does not show every feature of the invention specified in the claims." (emphasis added). Similarly, the Examiner maintains that the '296 patent "does not teach a milling device using for preparing the disc space between adjacent vertebrae to receive an endoprosthesis between, and the *original drawing* in the present application does not show an endoprosthesis received between adjacent vertebrae and the milling device works to prepare the disk space between the adjacent vertebrae." (emphasis added). The Examiner further states that "a method of using a milling device for repairing [sic] the disc space between adjacent vertebrae to receive an endoprosthesis is not in patent 5,674,296, and the *original specification* does not disclose how is the endoprosthesis installed in the vertebrae as shown in the new figs. 5-7." (Office Action, §10, page 7, first paragraph) (emphasis added).

The Examiner has thus improperly disregarded the disclosure and figures incorporated from the '296 patent, and incorrectly maintains that the original specification and figures must expressly disclose subject matter that is incorporated by reference. This position is directly contrary to the requirements of MPEP §608.01(p) as explained in *In re Goodwin*, 43 U.S.P.Q.2d 1856 (1997).

It is settled law that incorporation by reference has the same effect as if the specification had set forth the entire text of the incorporated patent. See *In re Lund*, 376 F.2d 982, 989, 153 U.S.P.Q. 625, 531 (CCPA 1967). Therefore, the incorporation by reference of the '296 patent in the present specification as filed was equivalent to the literal incorporation of each of Figs. 1-4 of the '296 patent (Figs. 4-7 of the present application) and the entire text of the '296 patent, including the disclosure corresponding to paragraphs 10, 40-46, and 47-53 of the substitute specification. Put simply, it is indisputable that expanding the disclosure of the substitute specification and figures to specifically set forth referenced material does not introduce new matter.

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VI. CONCLUSION

Applicants respectfully submit that the petition should be granted, and that the Examiner should be required to withdraw the objections to the substitute specification and Figs. 1-7, and to reconsider the patentability of the claims on the basis of the disclosure of the substitute specification and Figs. 1-7.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

Date: April 11, 2003

issued.³ As such, Crabb continued to be properly incorporated by reference at the time original application No. 07/167,374 was passed to issued by the examiner. *See In re Hawkins*, 486 F.2d 569, 574, 179 USPQ 157, 161 (CCPA 1973); *General Electric, supra*. That the examiner updated, at that time, the annotation of the referenced Crabb application, to include the patent No., was in accordance with the practice set forth in MPEP 1302.04 item No. 5. Indeed, MPEP 608.01(p) specifically requires that:

"[p]rior to the allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has issued as a patent. If the referenced application has issued as a patent, the examiner shall enter the U.S. Patent No. of the referenced application in the specification of the referencing application (see MPEP § 1302.04)."

That the examiner of the original application for patent properly accepted the initial incorporation by reference of Crabb, and furthermore, properly updated the then patented status of Crabb when the examiner, in turn, passed the original application for patent to issue, has settled the issue as to the propriety of the incorporation of Crabb. Since the totality of the Crabb application was incorporated by reference, any lack of particular direction to a specific portion(s) of the subject matter being bodily incorporated cannot negate the fact that the aforementioned subject matter was already incorporated, in application No. 07/167,347 as filed. Rather, MPEP 608.01(p) merely indicates that "particular attention should" be directed, not that such "must" be directed to the specific portions of the referenced document, in order to obtain a proper incorporation by reference.⁴ Clearly, such is a matter

³ Indeed, such would have been acceptable, even if the Crabb application became abandoned, as referenced abandoned applications become publicly available upon issuance of a patent to the host specification. *Fouche*, 439 F.2d 1239 n.1, 169 USPQ 431 n.1.

⁴ It is of no consequence that the original application incorporated by reference the Crabb material, whereas the instant application for re-issue bodily incorporates that same subject matter. *See Ernsthausen v. Nakayama*, 1 USPQ2d 1539, 1548 (BPAI 1986). Put simply, expanding the instant disclosure to specifically set forth referenced material does not introduce new matter. *Id.* Petitioners correctly further note that it would be illogical to hold the instant bodily incorporation improper, merely because Crabb also incorporates other information not relevant to the situation in hand. *See Ex Parte Maziere*, 27 USPQ2d 1705, 1707 (BPAI 1993). (Incorporation

of form which facilitates the identification and location of the incorporated subject matter, and does not go to the heart of the effectiveness of the incorporation *per se*.)

CONCLUSION

For the reasons given above, as a matter of procedure, the Crabb application was properly incorporated by reference at the time of filing of application No. 07/167,347 and at the time of issuance of the '464 patent to the aforementioned application.

This application is being returned to the Examiner of Group 1100 for further action consistent with this decision.

U.S. District Court
District of Kansas

Westport Historical Society v. Lee

No. 97-2130-GTV

Decided July 11, 1997

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1. Infringement pleading and practice — Jurisdiction (§217.05)

JUDICIAL PRACTICE AND PROCEDURE

Jurisdiction — Subject matter jurisdiction — In general (§405.0701)

Counterclaim seeking declaratory judgment of copyright infringement is dismissed for lack of jurisdiction, since registration of copyright is jurisdictional prerequisite to infringement suit, and since counter-plaintiff has not alleged that he owns registered copyright in allegedly infringed material; counter-plaintiff's motion to amend his complaint is denied, since proposed amendment alleges that counter-plaintiff has filed copyright registration but does not indicate

tion by reference is acceptable, and fulfills the requirements of 35 USC 112, § 1, even where the referenced application itself incorporates essential subject matter). Even assuming, *arguendo*, that the original incorporation by reference of essential subject matter from Crabb was improper, it is well settled that such essential material improperly incorporated by reference can be subsequently bodily incorporated into that specification. *Ernsthausen, supra*. Furthermore, that subsequent bodily incorporation does not constitute the insertion of new matter. *Id.* at 1547.

Lanham Act and have stated Lanham Act counterclaims for cancellation based upon abandonment, fraud, and false advertising. However, defendants' counterclaim for cancellation based upon failure to disclaim fails for lack of jurisdiction. Accordingly, plaintiff's motion to strike defendants' fifth affirmative defense and to dismiss defendants' counterclaims 2-5 (#20) is DENIED in part and GRANTED in part.

IT IS SO ORDERED.

**U.S. Patent and Trademark Office
Commissioner of Patents and Trademarks**

In re Goodwin

Reissue Application No. 08/375,399

Decided June 27, 1997
(Unpublished)

PATENTS

1. Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

Practice and procedure in Patent and Trademark Office — Reissue — In general (§110.1301)

Insertion in reissue application of portions of specification disclosure from application previously incorporated by reference in original application was not improper under Manual of Patent Examining Procedure 608.01(p), since original application properly incorporated co-pending application, and since incorporated application issued as patent prior to original application in present case, and thus was publicly available within meaning of 35 USC 112, and continued to be properly incorporated by reference, at time original application issued as patent; since totality of co-pending application was incorporated by reference in original application, lack of particular direction to specific portion of subject matter being bodily incorporated cannot negate fact that such subject matter was already incorporated in original application as filed.

Application of Dennis L. Goodwin and others (Re. 08/375,399, filed January 19, 1995) for reissue of patent no. 4,874,464, issued October 17, 1989 (process for epitaxial deposition of silicon). On applicants' request for reconsideration of denial of reissue claims. Granted.

[Editor's Note: The U.S. Patent and Trademark Office has not designated this decision as prepared for publication. It is not binding precedent of the Commissioner of Patents and Trademarks.]

Arthur S. Rose, of Knobbe, Martens, Olson & Bear, Newport Beach, Calif., for petitioner.

Kittle, Director, Patent Examining Group 1200.

This is in response to the petition filed May 7, 1997, requesting the Commissioner to invoke his supervisory authority under 37 CFR 1.181(a)(3) and review the Group Director's decision on petition mailed March 27, 1997. It will be treated as a Request for Reconsideration.

The Request is *granted*.

BACKGROUND

As filed, application No. 07/167,347, which led to the above-captioned patent, incorporated by reference two other commonly owned applications. Of interest here is application No. 07/108,771 filed June 24, 1987 naming as inventors R. Crabb *et al.* which ultimately issued on May 8, 1989 as U.S. Patent No. 4,828,224 (collectively, Crabb). The specification of application No. 07/167,347 indicated that heating was performed by radio-frequency (RF) induction, while the referenced Crabb disclosure indicated, *inter alia* that radiant (a.k.a. lamp) heating was employed.

The above-captioned patent is currently involved in litigation, docketed as *Advanced Semiconductor Materials America, Inc. v. Applied Materials, Inc.*, No. C-93-20853 RMW (N.D. Ca.). On April 16, 1996, the court issued an order entering a summary judgment that the above-captioned patent was invalid for failure to comply with the best mode requirement of 35 USC § 112, *vis-a-vis* the disclosure of RF, as opposed to lamp, heating.¹

The above-captioned reissue application was filed January 19, 1995. As part of the reissue process, *inter alia*, applicants bodily inserted portions of the specification disclosure, and Figures 1-8, of Crabb, which had been previously incorporated by reference, into the specification of the instant reissue application.

¹ Petitioners also assert that the court has now vacated that order and the litigation has been stayed pending this decision on petition.

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An Office action was mailed April 18, 1996, and a further Office action was mailed January 27, 1997. The latter action included *inter alia*: a statement by the examiner that the aforementioned bodily inserted material, as well as "radiant heating elements" was considered to be new matter; an objection to the specification due to its failure to set forth the best mode; and a rejection of all claims under 35 USC § 112 for the reasons set forth in the objection to the specification.

A petition (which also contains material subject to a protective order) seeking review of the position of the examiner was denied in the decision of the Group Director of March 4, 1997. The Director's decision acknowledged (at 2, 6) that, as filed, the above-captioned original application for patent properly incorporated Crabb, but held that subsequent events rendered that incorporation improper.

A petition requesting reconsideration of the Director's decision of March 4, 1997 was filed March 12, 1997, which latter petition was denied in the Director's decision of March 27, 1997. The latter Director's decision held that the incorporation of Crabb was improper under the procedures set forth in MPEP 608.01(p) in that: (1) Crabb itself incorporated essential subject matter by way of the six other incorporated applications (all now U.S. patents), and (2) the original incorporation statement failed to identify the specific portions of Crabb which were being incorporated.

Petitioners specifically request a decision limited to answering the procedural question "whether the incorporation by reference of the Crabb Patent was proper at the time of filing and at the time of issuance of the '464 patent."²

OPINION

It is well settled that the Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *See General Electric Co. v. Brenner*, 407 F.2d 1258,

² Petitioners have appropriately observed the line of demarcation between petitionable and appealable subject matter, in posing the question. *See* MPEP 1201. This decision is strictly limited to the procedural question raised on petition. It is well settled that the Commissioner will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board of Patent Appeals and Interferences. *See In re Dickerson*, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43, 44 (Comm'r Pat. 1971).

159 USPQ 335 (D.C. Cir. 1968). The purpose of the incorporation by reference policy of the PTO is to balance the convenience of ready access, by both the Office and the public, to the information *per se* incorporated into a U.S. Patent, with the offsetting inconvenience that all details which have been already set forth elsewhere, must be tediously repeated in yet another document. However, it is only necessary that the incorporated information that is relied upon be available to the public pursuant to 35 USC § 112, in order for that incorporation to be acceptable. *Id.*

[1] There is no dispute that, as filed, original application No. 07/167,347 properly incorporated Crabb. That is, the incorporation statement identified the Crabb application by both its application No., and its filing date, which is a sufficiently specific identification of the Crabb application to have effectuated incorporation of the entire Crabb disclosure into the above-captioned application. *See In re Fouché*, 439 F.2d 1237, 1239, 169 USPQ 429, 431 (CCPA 1971). Furthermore, it has not been shown, nor is it apparent, how events subsequent to the aforementioned successful original incorporation by reference, could operated to have rendered that original, successful incorporation by reference improper.

Petitioners assert that while MPEP 608.01(p) prohibits "double incorporation," such is immaterial to the instant application in that petitioners have only bodily incorporated herein material that is found within the "four corners" of Crabb. As such, petitioners assert, neither the initial incorporation by reference in the original application as filed, nor the instant bodily incorporation in the instant reissue application, falls within the prohibited practice set forth in MPEP 608.01(p). Petitioners' interpretation of that section of the MPEP is well taken.

Incorporation by reference has the same effect as if the host specification had set forth the entire text of the incorporated application. *See In re Lund*, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967). Thus, the incorporation by reference of Crabb set forth in original application No. 07/167,347, and the resultant above-captioned patent, is equivalent to the bodily incorporation of Crabb that is set forth herein. *Id.* Furthermore, as petitioners correctly observe, since Crabb issued prior to the above-captioned patent, there can be no doubt that Crabb was publicly available within the meaning of 35 USC 112, when the above-captioned patent